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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,340	11/15/1999	ERIC CHRISTIAN HINCE		2831

7590

01/28/2004

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EXAMINER

WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/440,340

Applicant(s)

HINCE ET AL.

Examiner

Deborah K. Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-26 and 28-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26 and 28-77 is/are rejected.
- 7) ☒ Claim(s) 24-26 and 28-77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 24-26 and 28-77 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Papers Filed

The change in power of attorney, extension of time and fee transmittal sheets filed June 24, 2003, have been received and scanned into the system. Also amendment faxed November 14, 2003, which is a copy of filed response of July 24, 2003 to last office action of March 24, 2003, was received and scanned as well.

Response to Amendment

Claim Objections

Claims 24-26 and 28-77 are newly objected to because of grammatical issues with respect to the placement of "selected" and it is suggested to change "selected as it appears in "a." and "b." of claim 24 to placement of –selected from—after "families". Thus, deletion of "selected" at each of lines 1 of "a." and "b." of claim 24 is requested. The same changes at lines 3- 4 of claim 30. Claims 47 and 76-77 are objected to because claims 47 and 76-77 depend from and/or alternatively depend from claim 27 which is a canceled base claim. Therefore, these claims can not depend from claim 27 and "27" should be deleted from claim 76 and "47" deleted from claim 77. Claim 47 should be canceled. Claim 32 is objected to because only one species is set

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forth and it is requested to simply delete further selected from the group consisting of” and insert –from the plant species—instead. A similar change is requested for claim 36 at line 2, insert –from species—and delete “further”. Also in claim 37 it is request to change “of the plant families” to –from the plant families—so simply changing “of” to –from—within this phrase. Claim 68-74 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims do not further limit the claim 24 from which all other claims depend from, because a dry mixture can not be cultivated in-situ; the dry mixture of these plant materials would not be growing in situ. It is suggested that these claims be canceled: claims 68-74.

Claim Rejections - 35 USC § 112

Claims 33, 42, 53, 62 and 77 are newly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 33 newly recites “cotton lint and other fibrous cotton-containing materials produced by the cultivation or processing of cotton” which does not appear to be well supported by the specification and is deemed new matter. Applicants are invited to show the examiners wherein

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support for this newly added language can be found in the original disclosure by page(s) and line number(s), or to cancel the new matter.

Claims 24-26 and 28-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24-26 and 28-77 are rendered vague and indefinite for failing to clearly set forth the function of “anaerobic bioremediation” and it is suggested to reinsert the phraseology as follows “which provides the capacity to extract and absorb hydrophobic chemical contaminants, and to promote the biodegradation thereof” (note that a “,” is added after “contaminants” above) and thereafter change “for the anaerobic bioremediation of chemical contaminants,” to –by anaerobic bioremediation of the chemical contaminants,--.

Claim 33 is rendered vague and indefinite for the recitation of “and other fibrous cotton-containing material produced by the cultivation of processing of cotton” wherein the metes and bounds of the claim can not be determined. It is suggested to delete this phraseology in the claim 33.

Claim 35 is rendered vague and indefinite for “further comprising a source of microorganisms” since “one or more microorganisms” are already required of claim 29, thus, it is suggested to delete “further” and reinsert it before “source” so it is more clear what further limitation is being added to the claim. Also the term “associated with” at line 4 is unclear as to what this means per se and it is suggested to change to – contained by— since the microorganisms would be expected to be present in the acid-

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mine drainage which is how the "yellow boy" is produced therein the drainage by the presence of the iron and sulfur and oxidizing microbes. Further, the deletion of "microorganisms associated with the" at line 6 is also requested and is suggested since it is not necessary with the above requested change.

Claim Rejections - 35 USC § 102/103

Claims 24, 29, 33, 36, 68, 72 and 74-76 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pinckard et al, cited of record, note pages 13-15, all lines of last action of March 24, 2003.

Response to Arguments

Applicant's arguments filed July 24, 2003 (and received faxed on November 14, 2003), have been fully considered but they are not persuasive. Applicant appears to be arguing that the difference between the claims and Pinckard is that the claims are directed to non-composted plant materials; however, the claims are not directed to this limitation. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., absorption of oil spills, direct application, non-composted plant materials, fiber-containing plant materials, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the composition and what it contains is what is considered for patentability purposes and not a process for how it is used and applied.

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The intended use of a product is not necessarily given any patentable weight because the product itself must stand on its own for purposes of patentability. However, Pinckard clearly teach bioremediation using the plant materials of their invention. Applicant's argument with regard to the form of the composition is not persuasive because the claims rejected over Pinckard are not limited to any forms of the composition.

With respect to anaerobic bioremediation and Applicant's allegation that such newly added limitation is silent in the reference teaching is noted, however, this argument is not sufficient to remove the rejection because Pinckard uses the same microorganisms and plant families and at least some of these are nitrogen fixers which can function facultatively and thus, include anaerobic bioremediation.

Furthermore, Applicant's argument that their invention has even a greater ability to consume oxygen or other high energy microbial electron acceptors so as to create and maintain anaerobic and reducing conditions is noted, however, the composition of Pinckard includes mineralization of the carbon in the contaminating compound or degradation by cometabolism or both induced by the microbial consortia occupying the plant material. Note col. 5, lines 45-55. Therefore, the arguments presented by Applicant are not deemed convincing and the claims remain rejected for reasons of record and for those discussed above.

Claims 24-26, 28, 30-31, 33, 37-40, 42, 44-48, 50-51, 53, 57-60, 72, 74, 66-70, 72, and 74-77 remain rejected under 35 U.S.C. 102(e) as anticipated by or, in the

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alternative, under 35 U.S.C. 103(a) as obvious over Clarke et al, cited of record, note pages 15-16, all lines of last action of March 24, 2003.

Response to Arguments

Applicant's arguments filed July 24, 2003 (and received faxed on November 14, 2003), have been fully considered but they are not persuasive. In response to applicant's argument that Clarke et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the compositions disclosed are described to be useful as cleaning agents, of which may be reasonably pertinent to bioremediation because detergents are often used in bioremediation either as the primary active ingredient or as a supplemental additive. For example, the use of dishwashing detergent for cleaning oil off of birds during reclamation efforts and bioremediation of oil contaminated sites is well documented. The plant materials are clearly disclosed and Applicant's claims do not omit plant gums since the claims are directed to plant materials. Plant materials may encompass plant gums. Therefore, neither Applicant's first or second argument are deemed persuasive. Finally, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., unprocessed plant materials such as fiber-containing plant materials) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, Applicants' arguments are not deemed convincing and the rejection is maintained.

Double Patenting

Claims 24-26 and 28-77 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,423,531 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of those reasons of record, note page 17, paragraph 11, all lines, last office action of March 24, 2003.

Response to Arguments

Applicant's arguments filed July 24, 2003 (received November 14, 2003), have been fully considered but they are not persuasive. The statute does not prohibit the rejection of claims under obviousness double patenting merely because instant claims under rejection and the applied reference patent are made by the same inventive entity, or assignee. All that is required is that the patented claims make obvious the instant claims for which another patent is being sought and one common inventor of the inventive entity and/or common assignee. The time of filing is not of relative importance when consider the issue of obviousness under this statute, so while Applicants' arguments are appreciated they are not deemed pertinent to the obviousness matter per se. The instant claims do not omit geochemical media nor does the intended use thereof prohibit this rejection.

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The same plant materials are used and the patented claims make obvious the claimed invention and therefore, the rejection is maintained. Applicants' arguments are not deemed convincing and furthermore, whether Applicants' believed that the claims would have been restricted is a matter of speculation at this point. Restriction practice is used during examination on a case by case basis at the discretion of the examiner. USPTO does have specific guidelines and rules that examiners apply for restriction purposes, however, the policies do vary from one art to the next. Restriction was not made and the instant claims are not drawn to some non-elected invention of another case, thus, the examiner is not prohibited from making an obviousness double patenting rejection as argued by Applicants.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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No claims are allowed, however, providing that Applicants make all of the above noted changes under the objections and 35 USC 112 sections as well as inserts –fiber-containing— at each occurrence of “plant materials” in the claims so that the term reads –plant fiber-containing materials— in the claims, the claims will be considered allowable. Applicants may phone the examiner to go over the necessary changes at the bold faced number below.

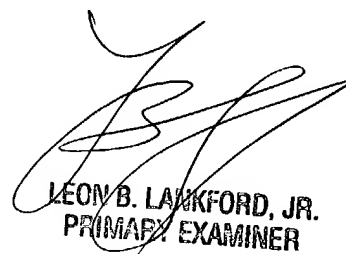
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is **571-272-0924**. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Deborah K. Ware
January 24, 2004



LEON B. LANKFORD, JR.
PRIMARY EXAMINER